

REMARKS / ARGUMENTS

The present application includes pending claims 1-29. Claims 13-15 and 21-28 have been allowed and claims 1-12 and 16-20 stand rejected. By this Amendment, claims 8-10, 12, 22-23, and 25-28 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. Claim 29 has been added. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that

the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1-5, 7-12, 16 and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,010,581, issued to Brown et al. (hereinafter, Brown). Claims 6 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown. The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 102

I. Brown Does Not Anticipate Claims 1-5, 7-12, 16 and 17

The Applicant first turns to the rejection of claims 1-5, 7-12, 16 and 17 under 35 U.S.C. 102(e) as being anticipated by Brown. With regard to the anticipation rejections under 102(b), MPEP 2131 states that "[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See id. (internal citation omitted).

A. Rejection of Independent Claim 1 under 35 U.S.C. § 102 (e)

With regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Brown does not disclose or suggest at least the limitation of "a second communications device operatively coupled to the network, the second communications device **receiving, from the first communications device, a device profile** relating to the first communications device," as recited by the Applicant in independent claim 1 (emphasis added).

The Office Action states the following:

[T]he teachings of Brown et al disclose of a system for reformatting media content (col. 4, lines 2-9). A transcoder farm, item #24 (server), is operably to a network (as shown in Figure 2). A client device, item 10 (first communication device), and proxy machine, item #11 (second communication device), are operably connected to the network (as shown in Figure 2). *The proxy machine (second communication device) receives client information (device profile) related to the client device (first communication device) from the client device (first communications device) and the proxy machine (second communication device) sends the client information (device profile) and media content to the transcoder farm (server)(col. 3, lines 50-52; col. 4, lines 2-9,34-35, & 42-55).* The transcoder farm (server) reformats the media content based on the client information (device profile)(col. 4, lines 6-9) (emphasis added).

See the Office Action at page 3. In his argument above, the Examiner is equating the client device 10, the proxy machine 11, and the transcoder farm 24 of Brown to the "first communication device", the "second communication device",

and the "server", respectively, as those terms are used in the Applicant's claim 1. Referring to Figure 2 of Brown, Brown states the following with regard to how the way information is processed by the proxy machine 11:

Referring again now to FIG. 2, as a **request** is sent from client device 10 to proxy machine 11, the request is sent to Web content server 30 after the client has been authenticated 45 as an authorized user of proxy machine 11. The response is then returned from Web content server 30, typically in HTML format, where it is **transcoded in transcoder farm 24 according to a user profile found in user data base 22.**

See Brown, column 4, lines 42-48 (emphasis added). In this regard, *Brown discloses that the client 10 communicates only requests, and not device profile information, to the proxy machine 11. Furthermore, Brown also discloses that the user profile (corresponding to the user of device 10) is stored in the user database 22 within the proxy machine 11, and not within the client device 10. The transcoder farm 24 obtains the user profile from the user database 22 and not from the client device 10.*

Therefore, the Applicant submits that Brown does not disclose or suggest at least the limitation of "a second communications device operatively coupled to the network, the second communications device receiving, from the first communications device, a device profile relating to the first communications device," as recited by the Applicant in independent claim 1. Accordingly, independent claim 1 is not anticipated by Brown and is allowable.

Independent claim 16 is similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claim 16 is also allowable over Brown at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-5, 7-12 and 17

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1 and 16 under 35 U.S.C. § 102(e) as being anticipated by Brown has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-5, 7-12 and 17 depend from independent claims 1 and 16, respectively, and are, consequently, also respectfully submitted to be allowable at least for the above reasons.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-5, 7-12 and 16-17.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second,

there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., "citing *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II. Brown Does Not Render Claims 6 and 18-20 Unpatentable

The Applicant now turns to the rejection of claims 6 and 18-20 as being unpatentable over Brown.

A. Independent Claim 18

With regard to the rejection of independent claim 18 under 103(a), the Applicant submits that Brown does not disclose or suggest at least the limitation of "a communications device operatively coupled to a network, **the communications device storing a revisable device profile** of the communications device, **sending the revisable device profile to a first communications device** operatively coupled to the network," as recited by the Applicant in independent claim 18 (emphasis added).

The Office Action states:

[I]t is disclosed by Brown et al of a system for reformatting media content (col. 3, lines 27-33). A client device (communication device) is operably connected to a network (as shown in Figure 2). The client (communications device) stores client information (device profile) and sends the client information (device profile) to the network (col. 4, lines 2-9). Media content is received from the network that has been reformatted based on the client information (device profile)(col. 3, lines 50-52; col. 4, lines 2-9,34-35, & 42-55). The teachings of Brown et al do not disclose that the client information (device profile) is updated or revisable. It is obvious to one of ordinary skill in the art at the time of the invention to have been motivated to allow client information to be modified based on changes to the client device (communications device).

See the Office Action at pages 6-7. Referring to Figure 2 of Brown, Brown states the following with regard to how the way information is processed by the proxy machine 11:

Referring again now to FIG. 2, as a **request is sent from client device 10 to proxy machine 11**, the request is sent to Web content server 30 after the client has been authenticated 45 as an authorized user of proxy machine 11. The response is then returned from Web content server 30, typically in HTML format, where it is **transcoded in transcoder farm 24 according to a user profile found in user data base 22**.

See Brown, column 4, lines 42-48 (emphasis added). In this regard, *Brown discloses that the client 10 communicates only requests, and not device profile information, to the proxy machine 11. Furthermore, Brown also discloses that the user profile (corresponding to the user of device 10) is stored in the user database 22 within the proxy machine 11, and not within the client device 10. The transcoder farm 24 obtains the user profile from the user database 22 and not from the client device 10.*

Therefore, the Applicant submits that Brown does not disclose or suggest at least the limitation of "a communications device operatively coupled to a network, the communications device storing a revisable device profile of the communications device, sending the revisable device profile to a first communications device operatively coupled to the network," as recited by the Applicant in independent claim 18. Accordingly, Brown does not render

independent claim 18 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 18 is allowable.

B. Rejection of Dependent Claims 6 and 19-20

Based on at least the foregoing, the Applicant believes the rejection of independent claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Brown has been overcome and requests that the rejection be withdrawn. Additionally, claims 19-20 depend from independent claim 18, and are, consequently, also respectfully submitted to be allowable.

Furthermore, claim 6 depends from independent claim 1, and is, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to claim 1.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 6 and 18-20.

CONCLUSION

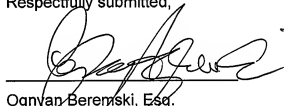
Based on at least the foregoing, the Applicant believes that all claims 1-29 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

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Respectfully submitted,



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